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PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of

Hiroji AGA et al.

Group Art Unit: 2823

Application No.: 09/857,803

Examiner: M. Estrada

Filed: June 11, 2001

Docket No.: 109725

For: METHOD FOR PRODUCING SOI WAFER AND SOI WAFER

RESPONSE TO RESTRICTION REQUIREMENT

Director of the U.S. Patent and Trademark Office  
Washington, D.C. 20231

Sir:

In a Lack of Unity of Invention Requirement mailed January 15, 2002, restriction was required between Group I (claims 1-5, drawn to a process of making a semiconductor device) and Group II (claims 6-9, drawn to a semiconductor device).

In response to the Lack of Unity of Invention Requirement, Applicants hereby elect Group I, claims 1-5. This election is made with traverse for the following reasons:

Applicants respectfully assert that the Requirement is improper under the rules of practice in PCT national stage applications, because the appropriate unity of invention standards have not been properly applied by the Patent Office. In PCT national stage applications, the Examiner may issue a restriction-type Requirement if no unity of invention exists. However, the Examiner must state why there is no "single general inventive concept." See MPEP §1893.03(d). Therefore, a single application may include one invention, or more than one invention if the inventions are "linked as to form a single general inventive concept." Id. (emphasis added). If multiple inventions are included in the application, they are deemed to be

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linked if there exists a "technical relationship among the inventions that involves at least one common or corresponding special technical feature." Id.

The Office Action asserts that unity of invention does not exist between Groups I and II because "the process of group I does not inherently form the product of group II because the recited surface roughness would not be obtained with all values of annealing temperature and annealing time recited." Applicants respectfully disagree.

Contrary to the assertion in the Office Action, Groups I and II are linked by a single general inventive concept that involves a common special technical feature. In this case, the special feature common to all claims is the product. Thus, as set forth in Example 1 of Annex B, Part 2, of the Administrative Instructions under the PCT, unity of invention exists between Groups I and II.

The Office Action appears to have focused on the inherency of the production of the claimed product by a particular process to the exclusion of all other considerations in determining whether the process of Group I is "specially adapted" for the manufacture of a product. However, the Applicants respectfully point out that the expression "specifically adapted" should not be construed to exclude the manufacture the product by variations of a single process or even different processes. The fact that variations of a method may be used to produce a particular product, does not in and of itself establish that a lack of unity of invention exists.

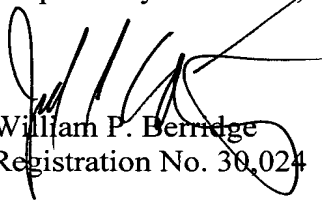
As long as a common technical feature and single general inventive concept applies to the asserted group of claims, unity of invention exists and restriction cannot be required. In this case, each of the process claims are linked by at least the product as a special technical feature. This relationship is sufficient to support the unity of invention between these claims.

Thus, because the Office Action has not properly demonstrated an absence of unity of invention under the rules, and because unity of invention in fact exists between Groups I and II, the Lack of Unity of Invention Requirement is improper and must be withdrawn.

Reconsideration and withdrawal of the Requirement are respectfully solicited.

Should the Examiner have any questions regarding this response or the application in general, he is invited to contact Applicants' undersigned attorney at the telephone number listed below.

Respectfully submitted,



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WPB/SXT:amw

Date: February 8, 2002

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